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In re Application of:
Kimikazu Matsumoto
Serial No.: 09/929,488
Filed: August 15, 2001
Attorney Docket No.: 250901/00

DECISION ON PETITION
TO VACATE OFFICE ACTION

This is a decision on the petition filed June 21, 2005, under 37 C.F.R. § 1.181, requesting entry of withdrawn claims 18 through 20 for the purpose of appeal and potentially available for rejoinder.

The petition is DISMISSED.

The application is in appeal status with an appeal brief, an examiner's answer and a reply brief having been filed. Petitioner requests clarification of the examiner's position regarding the rejoinder of withdrawn claims 18 through 20 and asserts that claims 18 through 20 be recognized as available for rejoinder.

As set forth under M.P.E.P. § 821.04, the propriety of the restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance. Rejoinder involves the withdrawal of the restriction requirement between the elected invention with allowable claims and the non-elected invention and examination of the claims of the formerly non-elected invention. In order to be eligible for rejoinder, a claim directed to the non-elected invention must depend from or otherwise require all the limitations of an allowable claim. A withdrawn claim that does not require all the limitations of an allowable claim will not be rejoined. M.P.E.P. § 821.04(b) addresses rejoinder of process requiring an allowable product relevant to the inventions in the instant application. However, since there is no allowable claim directed to the elected invention, no review or discussion regarding the applicability of Office policy of rejoining the process claims with the device claims is necessary at this time.


Since there is no allowable claim at this time, reconsideration of the restriction and consideration of the process claims for rejoinder with the device claims is premature at this time. Furthermore, withdrawn claims 18 through 20 have not been examined by the examiner. As such, to consider these claims at this time would require dismissing the appeal and reopening prosecution.

For the above-stated reasons, the petition is dismissed.

Petitioner may request reconsideration of this decision once a decision on appeal is rendered and is favorable to the petitioner.

The examiner will consider the reply brief as it pertains to the appealed claims and take appropriate action prior to passing jurisdiction to the Board of Patent Appeals and Interferences.

Any inquiry concerning this petition should be directed to Frank G. Font, Supervisory Primary Examiner, at (571) 272-2415.



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